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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1152	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>12/14/2005</u> Signature <u>Jamie Cameron</u> Typed or printed name <u>Jamie Cameron</u>		Application Number 09/304,379	Filed 05/04/1999
		First Named Inventor Michael Joseph Gardner	
		Art Unit 2668	Examiner Phuc H. Tran
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>44,395</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Signature <u>Steven L. Webb</u> Typed or printed name <u>(303) 938-9999 x 22</u> Telephone number <u>12/14/2005</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Practitioner's Docket No. 1152

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Michael J. Gardner

Application No.: 09/304,379

Group No.: 2668

Filed: 05/04/1999

Examiner: Phuc H. Tran

For: SYSTEM AND METHOD FOR CONFIGURING BANDWIDTH
TRANSMISSION RATES FOR CALL CONNECTIONS

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P. O. Box 1450
Alexandria, VA 22313-1450

Pre-Appeal Brief Request for Review

Introductory Comments

In response to the Office Action dated Nov. 14, 2005, please consider the following remarks.

Remarks

Claims 81-100 are pending. Claims 81- 89 and 91 -99 are rejected. Claims 90 and 100 are objected to as being dependent on a rejected base claim. Applicants respectfully traverse the rejection and request allowance of claims 81- 89 and 91 -99.

Claims 81-89 and 91 - 99 stand rejected under 35 U.S.C. §103(a) over U.S. Patent 6,324,279 (Kalmanek) and McGregor et al. (6,650,887) in further view of Classon et al. (6,700,867).

Classon et al. (6,700,867) was filed on Dec 20, 2001. The current application was filed May 4th, 1999. Therefore Classon does not qualify as prior art over the current application. The examiner relied on Classon et al for the 103(a) rejection. Because Classon does not qualify as prior art the examiner has not fulfilled the requirements for a *prima facie* case of obviousness and claim 81 and 91 are allowable as written.

Claim 81 requires:

“A communication system comprising:

a signaling processor configured to receive and process signaling for a call to select a connection, a bandwidth rate, an encoding scheme, and a billing rate, to transfer a first message indicating the connection, the bandwidth rate, and the encoding scheme, and transfer a second message indicating the billing rate to an accounting system; and

an interworking unit configured to receive the first message and user communications for the call, and in response, to apply the encoding scheme to the user communications and transfer the user communications over the connection at the bandwidth rate.”

The applicant believes that the examiner has equated the gate controller 110 of Kalmanek to the signaling processor of claim 81. The applicant also believes that the examiner has equated the network edge device 120 (also called an ER) to the interworking unit of claim 81. The applicant also believes that the examiner has equated the messages sent from the telephony interface unit 170 (also called a BTI) to the gate

controller 110 as the signaling received and processed by the signaling processor in claim 81. Applicant will base his arguments on this understanding.

Claim 81 requires a signaling processor that is configured to receive and process signaling to select a connection, a bandwidth rate, and an encoding scheme.

With respect to the bandwidth rate, Kalmanek teaches that the gate controller 110 sends a maximum bandwidth that may be requested through the gate (see column 35, lines 6 – 7) to the edge router (ER). The actual bandwidth used by the gate is determined by communications from the BTI to the ER (see column 28, lines 10 – 15). Claim 81 requires that the bandwidth rate used (not the maximum available) is sent from the signaling processor (not the BTI) to the interworking unit in the first message.

The examiner cites column 10 lines 13-20 showing that the network resources must verify the quality of service. The cited text relates to the maximum bandwidth allowable, not the actual bandwidth used. The cited text indicates that the network resources must verify that the “quality of service desired by a TIU is no greater than the QoS authorized...” (emphasis added). Clearly the cited text is once again limiting the maximum bandwidth allowable. The actual bandwidth used by the gate is determined by communications from the BTI to the ER (see column 28, lines 10 – 15). Thus, Kalmanek does not teach the claimed message between the signaling processor and the interworking unit to set the actual bandwidth used.

The examiner states in the response to arguments section of the current office action that “in claim 1, it does not teach “set the actual bandwidth used” it only teaches “select a bandwidth rate” therefore the selecting bandwidth is not limited to the actual bandwidth used”. The examiner is mistaken. Claim 1 requires that the bandwidth rate is selected by the signaling processor. Claim 1 also requires the interworking unit to “transfer the user communications over the connection at the bandwidth rate”. Therefore the bandwidth selected is the bandwidth that is used.

The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Here, there are a number of elements in claim 81 (discussed above) that are not taught in Kalmanek, therefore the examiner has not fulfilled the requirements for a *prima facie* case of obviousness. Therefore claim 81 is allowable as written.

Claim 81 requires a signaling processor that is configured to transfer a message indicating the billing rate to an accounting system. In Kalmanek it's a two step process. The gate controller first sends a billing message to the edge router (See Kalmanek, column 33, line 55 to column 34, line 9). Then the edge router sends the billing information to the accounting system. (See Kalmanek, column 5, lines 9-28). Thus Kalmanek does not teach that the signaling processor send the billing rate to the accounting system.

"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The examiner states that Kalmanek "fails to teach the billing rate transferring directly from the gate controller to the accounting system" (see page 3 of the current office action). The examiner then states it would have been obvious to modify Kalmanek to transmit the billing directly from the controller to the accounting system. The examiner does not "present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references" to support this statement. Therefore the examiner has not established a *prima facie* case of obviousness.

Because the examiner has not supported his modification to Kalmanek with a convincing line of reasoning, the applicant believes that the examiner has used unacceptable hindsight reasoning to modify Kalmanek.

Clearly, Kalmanek requires extremely intelligent TIUs (interworking units) to select connections, bandwidth rates, and coding schemes. This adds to the cost and complexity of the TIUs that must be present at each user site. Advantageously, the claimed invention greatly simplifies the TIU units of Kalmanek by placing intelligence in the signaling processor.

Applicants submit that there are numerous additional reasons in support of patentability, but that such reasons are moot in light of the above remarks and are omitted in the interests of brevity. Applicants respectfully request allowance of claims 81-100.


SIGNATURE OF PRACTITIONER

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